



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,913	08/15/2001	William J. Braun	24534-080000	1702

7590 07/14/2005

Stephen T. Scherrer  
McDermott, Will & Emery  
31st Floor  
227 West Monroe Street  
Chicago, IL 60606

EXAMINER

DASS, HARISH T

ART UNIT	PAPER NUMBER
----------	--------------

3628

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/930,913

Applicant(s)

BRAUN ET AL.

Examiner

Harish T. Dass

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Apgar, IV (hereinafter Apgar - US 5,680,305) in view of Ruffin et al (hereinafter Ruffin - US 6,675,149).

Re. Claims 1 and 17, Apgar discloses systems and methods of the invention provide objective evaluations of a business entity's real estate situation and condition for use by customers including (but not limited to) the business entity [see entire document particularly Abstract; C1 L1 to C6 L67], inputting information into a means for processing the information wherein the information comprises financial data and non-financial data relating to the real estate asset [C1 L6-L50; C3 L36-L50; C15 L41 to C16-L20; C19 L20-L24], processing the financial data and the non-financial data into indicator values representing the financial data and the non-financial data with the computer [See Figures 19-21; C1 L 53 to C3 L14; C4 L1-L61; C13 L27 to C15 L23], evaluating the indicator values for the financial data and the non-financial data to get a total score for each financing structure with the computer [Abstract; Figure 21; C5 L20-L31],

Art Unit: 3628

and outputting the total scores for each financing structure to compare the total scores of for each financing structure [C21 L64 to C22 L19; C31 L14 to C32 L32]. Apgar does not explicitly disclose outputting the total score for each financing structure from the computer to compare the total scores of all financing structures. However, Ruffin et al (hereinafter Ruffin - US 6,675,149) discloses this step [see entire document particularly, Abstract; Figure 2 (#201, 207-208), 4 (# 405), 9: C1 L15-L30; C3 L1-C4 L48 -- see different type of business service or solution scenarios] to generate a numerical valuation on the on a given property and generate a set of solutions. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosure of Apgar and Ruffin to generate outputs as a proposal based on evaluations for a given property and generate a set of solutions.

Re. Claims 2, Apgar discloses assigning and applying weights to the indicator values that represent the importance of the financial data and the non-financial data for each financing structure [Figures 3, 5, 20; C8 L49 to C9 L5; C11 L17-L18; C17 L37-L67], and evaluating the weighted financial data and the non-financial data to get a total score of the financial data and the non-financial data for each financing structure [Abstract; Figures 20-21; C5 L20-L31].

Re. Claims 3, Apgar discloses wherein the financing structures comprise an ownership financing structure and a leasehold financing structure [C2 L62 to C3 L14; C22 L20 to C23 L59].

Art Unit: 3628

Re. Claims 4-6, Apgar discloses business entity ownership, small, large, bank, insurance, etc. (wherein the financing structures may be selected from the group consisting of: ownership using corporate funds, ownership with debt, a real estate investment trust, a partnership, a joint venture, a short-term lease, a long-term lease, a credit sale/leaseback, a tax-motivated leveraged lease, and a synthetic lease) [C3 L50 to C4 L24].

Re. Claim 7, Apgar discloses manipulating the financial data into performance metrics and assigning weights to the performance metrics to determine a financial data total score [Figure 14 # 382; C24 L58-L58; C31 L14 to C32 L32].

Re. Claim 8, Apgar discloses changes in capital markets structure lead to reevaluation of real estate investments, including interest rates, real estate supply and demand, and investment rates of return (wherein the financial data is selected from the group consisting of: a net present value after tax factor, an economic value-added factor, a total debt to capital factor, a capital requirement factor, a P&L cost impact factor, an EBIT interest coverage factor, an EBITDA interest coverage factor, a free cash flow to total debt factor, a funds from operations to total debt factor, a diluted EPS from continuing operations factor, an operating profit/net sales factor, a return on assets factor, a return on equity factor, and a return on total capital factor) [C3 L35 to C4 L61].

Art Unit: 3628

Re. Claim 9, Apgar discloses square footage data representing square footage of the Real Estate (wherein the non-financial data is selected from the group consisting of; a strategic importance factor, a facility size factor, a replacement cost factor, a degree user specific factor, a market value/book value factor, a length of commitment factor, a certainty of occupancy factor, a flexibility factor, a market conformance factor, a size of market factor, a quality of market factor, and a rent/value trend factor) [C3 L35 to C4 L61].

Re. Claims 10-16, neither Apgar nor Ruffin explicitly disclose a) wherein the information relates to financial data of the entity desiring to procure the real estate asset, b) evaluating the entity desiring to procure the real estate asset (loan approval) and the real estate asset for the financial and the non-financial data, c) evaluating the real estate asset and the entity desiring to procure the real estate asset, and designing a model that processes the financial and the non-financial information into the indicator values, d) wherein the evaluation of the entity comprises reviewing documentation of the entity and interviewing personnel from within the entity, e) processing the financial factors into performance metrics of the entity desiring to procure the real estate asset, f) converting the financial information into standardized units prior to assigning the indicator values to the financial information, and g) performing a sensitivity analysis of performance metrics for each financing structure. However these are know steps in real estate dealing and real estate practice in other word: a) wherein the information relates to financial data of the entity desiring to procure

Art Unit: 3628

the real estate asset (is a loan application; example Uniform Residential Form application form 1003), b) evaluating the entity desiring to procure the real estate asset (loan approval) and the real estate asset for the financial and the non-financial data (is property appraisal), c) evaluating the real estate asset and the entity desiring to procure the real estate asset, and designing a model that processes the financial and the non-financial information into the indicator values (are document preparation for underwriting), d) wherein the evaluation of the entity comprises reviewing documentation of the entity and interviewing personnel from within the entity (is underwriting), e) processing the financial factors into performance metrics of the entity desiring to procure the real estate asset (is underwriting), f) converting the financial information into standardized units prior to assigning the indicator values to the financial information (is underwriting), and g) performing a sensitivity analysis of performance metrics for each financing structure (is underwriting). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Apgar & Ruffin and include steps a-g to provide evaluation method for real estate transaction such as leasing, rent, purchase, etc. which complies with modern real estate practice where different parties are involved.

Re. Claim 18, claim 18 is rejected with same rational as claim 2.

Re. Claim 19, claim 19 is rejected with same rational as claims 4-6.

Re. Claim 20, claim 20 is rejected with same rational as claim 9.

***Response to Arguments***

2. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.



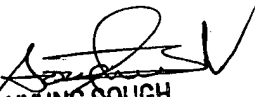
Art Unit: 3628

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harish T Dass  
Examiner  
Art Unit 3628

7/10/05

  
HYUNG SOUGH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600